

Appl. No. 10/792,149  
Docket No. 9173L  
Amdt. dated April 28, 2006  
Reply to Office Action mailed on July 28, 2006  
Customer No. 27752

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## REMARKS

### Claim Status

Claims 1 - 23 are pending in the present application. No additional claims fee is believed to be due.

Claims 1 and 23 have been amended to change that the liquid permeable first filter member is engaged instead of sealed to the fluid distribution member. Support for the amendment is found in FIGS. 1 - 10 of the specification. Claims 1, 22, and 23 have also been rewritten to more specifically characterize the fluid distribution member as being liquid permeable. Support for this amendment is found at page 11, line 10 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

### Rejection Under 35 USC §102 Over Werner

Claims 1-3, 8 - 10, 16 - 19, and 21 have been rejected under 35 U.S.C. §102(b) as anticipated by Werner et al. (U.S. Patent 2,926,594). The office action contends that Werner shows all of the essential components of Applicants' claimed liquid infusion pod. Such a rejection is respectfully transversed as it would apply to the claims as amended herein.

Applicants submit that the Werner patent does not anticipate Applicants' Claim 1. Claim 1 has been amended by this response. Claim 1 requires that "the first filter member is engaged to the fluid distribution member." The Werner patent does not disclose a first filter member that is engaged to the fluid distribution member. In fact, the Werner patent discloses a cloth bag 10 which fits around a disc 16. (Column 1, lines 66 - 70). Furthermore, the Werner patent does not disclose the first filter member engaged to the fluid distribution member to form a first interior chamber. In contrast, the Werner patent has "only" the cloth bag 10 forming a first interior chamber.

Given the foregoing distinctions between the elements of the infusion device of the Werner reference and the elements of the infusion pod now claimed as Applicants' invention, it is submitted that the Werner reference cannot properly be characterized as

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anticipatory of Applicants' amended Claim 1 under 35 U.S.C. §102(b). Claims 2 -3, 8 - 10, and 16 - 19 all depend from claim 1 either directly or indirectly and are thus believed to be patentable over Werner for the same reasons as claim 1. Such a rejection should therefore be withdrawn with respect to these claims.

Rejection Under 35 USC §103(a) Over Cai in view of Clermont

Claims 1 - 3, 8 - 10, 14, and 16 - 22 have been rejected under 35 USC §103(a) as being unpatentable over Cai in view of Clermont. Applicants transverse these rejections.

It is basic patent law that the rejection of the present invention under 35 U.S.C. § 103 must comport with the standard set forth in *Graham v. John Deere Company* 383 US1, 148 USPQ 459 (1966), explained in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must

- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (3) Explain why the proposed modification would be obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch*, 922 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

With respect to independent Claim 1, 22, and 23, Applicants respectfully submit that the combined disclosures of Cai and Clermont would not lead the skilled artisan to a realization of Applicants' invention. Attention is directed to the fact that neither Cai nor Clermont 146 teach or disclose all of the elements of Claim 1. Namely, neither Cai nor Clermont disclose a liquid permeable fluid distribution member. Accordingly, it is submitted that there is no motivation in either reference to combine the pod disclosed Cai with the percolation apparatus disclosed in Clermont. Namely, the Clermont patent does not disclose the need for a pod. In fact, the apparatus is not built structurally to include a pod. (See Clermont).

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In light of the case law, it is submitted that the rejection of Claim 1, 22, and 23 as obvious over Cai in further view of Clermont is improper. It is requested that such a rejection should be reconsidered and withdrawn.

Claims 2 -3, 8 - 10, 14, and 16 - 20 depend from Claim 1 and are allowable for the same reasons given above with respect to Claim 1. Therefore, the Examiner is respectfully requested to withdraw the rejection of Claims 1 - 23 and allow these claims.

Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (BPAI 1992). The Examiner's rejection is not specific as to how one of ordinary skill in the art would have found it Claims 1-23 of the claimed invention obvious. For this reason alone, the rejection should be withdrawn.

#### Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §102 and 35 U.S.C. §103 . Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1- 23 is respectfully requested.

Respectfully submitted,

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(Amendment-Response to Office Action.doc)

Revised 04/25/2006